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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/736,617

12/13/2000

Douglas S. Makofka

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Motorola, Inc.  
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EXAMINER

SALCE, JASON P

ART UNIT

PAPER NUMBER

2623

NOTIFICATION DATE

DELIVERY MODE

06/13/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.Schaumburg@motorola.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 09/736,617	<b>Applicant(s)</b> MAKOFKA ET AL.	
	<b>Examiner</b> Jason P. Salce	<b>Art Unit</b> 2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8,10-15 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-15 and 17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Inventorship*

In view of the papers filed 3/22/2005, the inventorship in this nonprovisional application has been changed by the addition of Reem Safadi, Lawrence D. Vince and Eric J. Sprunk.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

### *Response to Arguments*

Applicant has made a statement of common ownership and argues that according to MPEP § 706.02(I)(2) Section II (***regarding 103(c) rules***) establishes that a clear and conspicuous statement of common ownership, given by an attorney or agent of record in a separately labeled section of a response, alone is sufficient evidence to disqualify a patent application publication from being used in a rejection under 35 U.S.C. 103(a) against the claims of a pending application.

The examiner disagrees that the Safadi reference can be disqualified as prior art based on a statement of common ownership because the Safadi reference is not being applied as a 102(e) reference, but instead has been applied as a 102(a) reference in the 103(a) combination. In accordance with 35 U.S.C. 103(c) and the guidance set forth in MPEP 706.02(I)(3), U.S.C. 103(c) does not apply to or affect subject matter that qualifies as prior art under any other subsection of 35 U.S.C. 102 (e.g., 35 U.S.C.

102(a) or (b)). Subject matter qualifying under other subsections (e.g., 35 U.S.C. 102(a) or (b)) will not be disqualified as prior art under 35 U.S.C. 103(c) due to common ownership. The Safadi publication, as relied upon in the ground of rejection, qualifies as prior art under 35 U.S.C. 102(a), and therefore, cannot be disqualified as prior art under 35 U.S.C. 103(c) based upon the declaration asserting common ownership. Applicant can only overcome the Safadi reference either by showing under 37 CFR 1.132 that the invention disclosed therein was derived from the inventor of this application, and is therefore, not the invention "by another", or by antedating the applied art under 37 CFR 1.131 (see MPEP 2132.01).

Applicant has further provided a 1.131 Affidavit and argues that the rule 131 affidavit establishes that the instant invention was conceived and reduced to practice prior to the publication date of the Safadi reference. As stated in the previous Office Action, MPEP 715.07 [R-3] Section III states that there are three ways to show prior invention by the use of a 1.131 Affidavit: Actual reduction to practice, conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

The 131 affidavit clearly states that a constructive reduction to practice is being applied, however as stated in MPEP 715.07 [R-3] such a constructive reduction to practice approach, must be "**coupled with due diligence from prior to the reference**

**date to the filing date of the application**". This section further states that "**A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT**".

Contrary to providing evidence that the invention was reduced to practice, the "Invention Record Form" (**Page 6**) of the affidavit clearly discloses at question 8, "**Has a working model of the invention been built and tested (or appropriate software been written)?**", in which the response to this question has been marked as "No".

Although the invention record form shows evidence that the idea of the invention's implementation was conceived, no further evidence proving due diligence (**showing that the invention was reduced to practice**) has been provided. Therefore, the evidence provided in the affidavit is insufficient and the rejection stands (**see below**).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 8, 10-13, 15 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safadi et al. (International Application Published Under PCT WO 00/50978) in view of Maillard et al. (U.S. Patent No. 6,393,562).

Referring to claim 1, Safadi discloses receiving first information comprising a plurality of functional unit identifiers (see Page 6, Lines 10-12 for creating a fingerprint (digital signature) for each software object) and one or more tier requirements respectively related to each functional unit identifier (see Page 7, Lines 3-4 for associating a fingerprint for each software object with a service tier).

Safadi also discloses receiving second information comprising tier rights (see Page 7, Lines 27-29 and Page 10, Lines 11-16 for the use of an EMM in order to provide access to a downloaded option or a specific resource at the set-top box). Also note that the EMM is specifically associated with authorization rights.

Safadi also discloses correlating the functional unit identifiers to their respective tier requirements (see Page 8, Lines 7-27 for correlating the fingerprints to the service tier and adding additional data according to which controller (National or Local) is used, and incorporating the data into an entitlement control structure (ECS)). Also note that the ECS is specifically associated with access requirements (see Page 8, Lines 25-27).

Safadi also discloses interacting with the functional unit (see Page 11, Lines 14-17 for downloading or utilizing an object).

Safadi also discloses determining if the respective tier requirements are satisfied by the tier rights (see Page 11, Lines 14-17 for comparing the authorization rights (EMM) against the authorization requirements (ECS)).

Safadi also discloses authorizing further interaction with the functional unit (see Page 14, Lines 12-14 for authorizing permission to interact with a functional unit).

Safadi discloses receiving third information (see Page 13, Lines 25-29 and Page 14, Lines 8-12 for receiving an EMM each time a resource is requested from a software object), but fails to teach that the third information replaces the tier rights.

Maillard also teaches the distribution of multiple EMMs, which replaces a previously sent EMM with a current EMM (according to the date information) (see Column 6, Lines 53-55 and Lines 60-64 and Column 7, Lines 10-16 and Lines 22-29 for replacing tier rights data of a previous EMM data with the current EMM data).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the set top box, as taught by Safadi, using the EMM data verification receiver, as taught by Maillard, for the purpose of preventing fraudulent access in a conditional access system linked to a subscriber's receiver/decoder (see Column 1, Lines 9-10 of Maillard).

Referring to claim 3, Safadi discloses that more than one of the tier rights could authorize further interaction with the functional unit (see Page 7, Lines 27-29 for authorization tiers for which a user has been authorized in conveyed in an EMM, therefore since multiple tiers are authorized, then more than one of the tier rights of the EMM can be used to authorize interaction with a functional unit). Also note Page 7, Line 30 through Page 8, Line 6 for two types of tiers, which can be authorized for use. Also note Page 10, Lines 28-31 for sending an EMM to the set-top box with multiple "access rights" for accessing services and objects.

Referring to claim 4, Safadi discloses authenticating a source of at least one of the first and second information (see Page 6, Lines 15-16 for encrypting the fingerprint (first information) and Page 12, Line 31 through Page 13, Line 6 for authenticating that the fingerprint was sent from specific source at the set-top box).

Referring to claim 5, Safadi discloses that the functional unit comprises a discrete entity comprising software (see Page 5, Lines 30-32 for the set-top box utilizing a software object (functional unit)).

Referring to claim 6, Safadi discloses receiving a plurality of non-streaming content functional units (see Page 4, Third Paragraph of the applicant's specification for a functional unit being a software program (object), therefore the software object disclosed by Safadi at Page 5, Lines 30-32 is a functional unit). Also note that the functional unit can only be "non-streaming content" as opposed to "streaming content" disclosed in claim 6.

Referring to claim 8, see the rejection of claim 1. Also note that a set top box is taught by Safadi in Figure 1 (element 350a) and that a functional unit is associated with the set top box (see Page 5, Lines 30-32). Also note that the requirements message and rights message are disclosed in the rejection of claim 1 as the first and second information, respectively.

Referring to claim 10, Safadi discloses a data channel between a headend and the set top box (see Page 6, Lines 3-9 for interaction between a headend (NAC or LAC) and a set top box and Page 7, Lines 3-5 for a satellite or cable communications path), wherein the data channel is bi-directional (see Page 11, Line 20 for requesting



download of a software object and Page 13, Lines 25-29 for downloading the software object upon approval). Therefore, since a request is being sent (upstream) and a download is being received (downstream), then the communications path is bi-directional.

Referring to claim 11, see the rejection of claim 1.

Referring to claim 12, see the rejection of claim 6.

Referring to claim 13, see the rejection of claim 5.

Referring to claim 15, Safadi discloses determining first and second information ((see Page 6, Lines 10-12 and Page 7, Lines 3-4 for determining the first information (fingerprint and service tier (grouping of services)) and Page 7, Lines 27-29 for determining the second information (EMM)) to modify authorization of a remotely located and functional unit (see Page 11, Line 32 through Page 12, Line 14 for authorizing downloading a remotely located software object and Page 14, Lines 8-12 for authorizing access to the remotely located software object that has been approved for download).

Safadi also discloses sending the first information comprising a functional unit identifier and at least one tier requirement related to the functional unit identifier (see the rejection of claim 1 for sending the fingerprint and tier requirement data).

Safadi also discloses sending the second information comprising a tier right (see the rejection of claim 1 for sending the EMM containing the tier rights).

Safadi also discloses causing modification of an authorization state of the remotely located functional unit corresponding to the functional unit identifier (see again

Page 11, Line 32 through Page 12, Line 14 for determining if the state of authorization requires the software object to be downloaded or not).

Safadi also discloses further modification of the authorization state of the remotely located and functional unit corresponding to the functional unit identifier (see Page 14, Lines 8-12 for determining if the state of authorization requires the software object to be accessed or not).

Safadi discloses receiving third information (see Page 13, Lines 25-29 and Page 14, Lines 8-12 for receiving an EMM each time a resource is requested from a software object), but fails to teach that the third information replaces the tier rights.

Maillard also teaches the distribution of multiple EMMs, which replaces a previously sent EMM with a current EMM (according to the date information) (see Column 6, Lines 53-55 and Lines 60-64 and Column 7, Lines 10-16 and Lines 22-29 for replacing tier rights data of a previous EMM data with the current EMM data).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the set top box, as taught by Safadi, using the EMM data verification receiver, as taught by Maillard, for the purpose of preventing fraudulent access in a conditional access system linked to a subscriber's receiver/decoder (see Column 1, Lines 9-10 of Maillard).

Referring to claim 17, Safadi teaches an authorized and unauthorized state (see Page 11, Line 32 through Page 12, Line 14 to determine if downloading a software object is authorized or not authorized).

Referring to claim 18, see the rejection of claim 4. Also note that the fingerprint of the first information (see the rejection of claim 1) is a digital signature.

Referring to claim 19, see the rejection of claim 3.

Referring to claim 20, see the rejection of claim 6.

Referring to claim 21, see the rejection of claim 5.

Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safadi et al. (International Application Published Under PCT WO 00/50978) in view of Dyer (U.S. Patent No. 6,305,019).

Referring to claim 7, Safadi discloses a set top box (element 350a in Figure 1), but fails to disclose that the set top box is integral with an enclosure for a display (integrated inside a television).

Dyer discloses integrating a set top box within a television (see Column 14, Lines 35-40).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the set-top box, as taught by Safadi, to be integrated inside a television, as taught by Dyer, for the purpose of forming a single consumer electronics product (see Column 14, Lines 36-37 of Dyer) which would reduce the amount of space taken up at the consumer premises.

Referring to claim 14, see the rejection of claim 7.

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Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Safadi et al. (International Application Published Under PCT WO 00/50978) in view of Wasilewski et al. (U.S. Patent No. 6,157,719).

Referring to claim 9, Safadi discloses authentication of a source of the requirements message (see the rejection of claim 4 for authentication of the ECS), but fails to teach authentication of the rights message (EMM).

Wasilewski also teaches a conditional access system similar to Safadi that transmits EMMs to a user for authentication (see Column 4, Lines 5-8). Wasilewski also teaches that the EMMs can be encrypted (see Column 6, Lines 60-64), therefore authenticating data sent from a specific source (see Column 7, Lines 1-6).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the rights message (EMM), as taught by Safadi, by utilizing encryption of the EMM, as taught by Wasilewski, for the purpose of protecting information that is transmitted by means of a wired or wireless medium against unauthorized access (see Column 1, Lines 53-55 of Wasilewski).

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### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/  
Primary Examiner, Art Unit 2623

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